



Central Division
Paris Seat

ORDER
of the Court of First Instance of the Unified Patent Court
Central division (Paris seat)
issued on 29 April 2025
concerning the application for a cost decision No. App_6322/2025
UPC_CFI_98/2025

HEADNOTES: 1. The application to set aside the decision by default constitutes an internal procedural remedy and, as such, is not suitable for giving rise to a decision on the merits and, therefore, does not require a decision on the obligation to bear the associated costs. Consequently, the costs incurred by the successful party in this step can be claimed and assessed within the proceedings for a cost decision related to the main proceedings which concluded with the decision by default.

KEYWORDS: decision by default; procedure for cost decision.

APPLICANT:

Bayerische Motoren Werke Aktiengesellschaft - Petuelring 130, 80809 München, Germany
represented by Johannes Lang, Bardehle Pagenberg Partnerschaft mbB

RESPONDENT:

ITCiCo Spain S.L. - C/Pau Piferrer 17 07011, Palma de Mallorca, Spain
represented by Robin Hayes

PATENT AT ISSUE:

European patent n° EP 2 796 333

PANEL:

Panel 2:

Paolo Catalozzi

Presiding judge and judge-rapporteur

Tatyana Zhilova

Legally qualified judge

Dörte Otten-Dünnweber

Technically qualified judge

DECIDING JUDGE:

This order has been issued by the Presiding judge and judge-rapporteur.

SUMMARY OF FACTS AND PARTIES' REQUESTS:

1. On 10 February 2025 the applicant lodged an application for a cost decision, pursuant to Rule 151 of the Rules of Procedures ('RoP'), registered as No. App_6322/2025 UPC_CFI_98/2025, requesting that the Court determines the costs incurred with regard to the application to set aside the decision by default issued in the revocation action proceedings registered as No. ACT_585518/2023 UPC_CFI_412/2023 in the amount of euro 15,731,00.

GROUND FOR THE ORDER:

2. It should be noted, for a better understanding of the application, that on 16 September 2024 this Court issued a decision by default (no. ORD_51965/2024) upon the request of the applicant in the revocation action concerning the patent at issue, registered as No. ACT_585518/2023 UPC_CFI_412/2023, and revoked the patent in its entirety with regard to the territories of the Contracting Member States for which it had effect at the date of the filing of the revocation action. Hence, the panel ordered that the costs of the proceedings shall be borne by the defendant.
3. The respondent filed an application pursuant to Rule 356 of the Rules of Procedure ('RoP') requesting the Court to set aside the decision by default, but this application was dismissed by order issued by the panel on 9 January 2025 (no. ORD_58414/2024). This order contains no provision regarding the obligation to bear the legal costs associated with the examined application.
4. The applicant requested the Court to rectify the order of 9 January 2025 to supplement it by ordering that the defendant also bears the costs of the proceedings for the application to set aside the Court's decision by default. By order no. ORD_15677/2025 issued on 31 March 2025 the Court rejected the request.
5. In that order the Court stated that the application to set aside the decision by default constitutes an internal procedural remedy and, as such, is not suitable for giving rise to a decision on the merits and that the costs incurred by the successful party in this step can be claimed and assessed within the proceedings for a cost decision related to the main proceedings which concluded with the decision by default.
6. This Court intends to confirm these principles.

7. It may in any case be added that the activity for which the applicant seeks the compensation of the costs incurred consists of the preparation of comments and a rejoinder to the respondent's request to set aside the decision by default, which concerned aspects relating to the validity of the notification made to the respondent that had already been extensively addressed during the proceedings that led to the decision by default. It can therefore be considered that the application for a cost decision already formulated in relation to the main proceedings and finalized by order n. ORD_19001/2025, issued on 21 April 2025, already takes into account this procedural activity, and thus, that order also satisfies the request advanced by the applicant in the current proceedings.
8. It follows that the application must be dismissed.

ORDER

The Court,

rejects the application for a cost decision filed by Bayerische Motoren Werke Aktiengesellschaft.

Issued on 29 April 2025.

The presiding judge and judge-rapporteur

Paolo Catallozzi

ORDER DETAILS

Order no. ORD_20395/2025 in ACTION NUMBER: ACT_585518/2023

UPC number: UPC_CFI_98/2025

Action type: Revocation Action

Related proceeding no. Not provided Not provided

Not provided Not provided